

REMARKS

Claim 1-12 and 14-42 are pending, and claims 23-28, 40 and 41 have been amended with this action. Support for amendments to claims 23-28, 40 and 41 can be found in the original claims as filed as well as throughout the specification. These amendments add no new matter. Applicants reserve the right to pursue unclaimed subject matter at a later date.

In the Office Action dated May 5, 2004, the Examiner states "rejections not repeated in this Office action are hereby withdrawn." Applicants gratefully acknowledge that the Examiner has thereby withdrawn the previously made rejections under 35 U.S.C. §102 in view of Cohen *et al.*, under 35 U.S.C. §103 in view of Cohen *et al.* and Baracchini *et al.*, as well as under 35 U.S.C. §112, 1st paragraph (enablement). Applicants further gratefully acknowledge that all rejections to claims 16-22, 29 and 30 have been removed and these claims have been allowed. Applicants' responses to the Examiner's new rejections under 35 U.S.C. §112, 2nd and 35 U.S.C. §112, 1st (written description) are presented below.

Rejection under 35 U.S.C. §112, 2nd Paragraph

Claims 23-28, 40 and 41 have been rejected under 35 U.S.C. §112, second paragraph, as "being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." In particular the Office Action states "it is unclear what the metes and bounds of the term 'has' preceding 'SEQ ID' are." The Office Action further states "perhaps replacing 'has' with -comprising- would be remedial." Accordingly, Applicants have amended claims 23-28, 40 and 41 to replace the word "has" with the word "comprises," as recommended by the Examiner. Reconsideration and removal of this rejection is, therefore, respectfully requested.

Rejection under 35 U.S.C. §112, 1st Paragraph

Claims 1-12, 14, 15 and 31-39 have been rejected under 35 U.S.C. §112, first paragraph, as "failing to comply with the written description requirement." In particular, the Office Action states that "the limitation recited in claim 1, line 5, 'does not have the sequence set forth as SEQ

ID NO: 4, constitutes a new limitation...and so it constitutes new matter.” Applicants traverse this rejection for the reasons that follow.

Applicants respectfully direct the attention of the Examiner to § 2173.05(i) of the MPEP, entitled “Negative Limitations.” A line of cases in the chemical arts has established that an element of an Applicants’ invention, adequately described as a part of that invention, can be explicitly excluded from the claimed invention by the Applicant. Indeed, this section of the MPEP states that “[if] alternative elements are positively recited in the specification, they may be explicitly excluded in the claims” (emphases added, citing *In re Johnson*, 558 F.2d 1008, 1019 (CCPA 1977) (“[the] specification, having described the whole, necessarily described the part remaining.”). The issue in *Johnson* was whether the Applicants’ explicit exclusion of a part of their invention by provisos that included, in claim 1, “E and E’ may not both include a divalent sulfone group,” was new matter which precluded Applicants from claiming the benefit of their original 1963 filing date. This negative limitation excluded species of the lost count of an Interference. While the Board of Appeals had found that “no antecedent basis exists in the parent case” for the “limited genus” in claim 1, the reviewing court reversed, stating “inventions are constantly made which turn out not to be patentable, and applicants frequently discover during the course of prosecution that only a part of what they invented and originally claimed is patentable.” *Id.* at 1018.

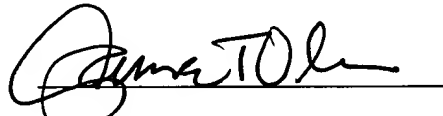
In the instant case, Applicants have made a post-filing amendment excluding a specifically-described part (*i.e.* an oligonucleotide having the sequence of SEQ ID NO: 4) of a broader aspect of the invention that has been described with great detail (*i.e.*, ‘an oligonucleotide having a nucleotide sequence consisting of 21 nucleotides of the sequence set forth as SEQ ID NO: 5...’). Accordingly, independent claim 1, and claims 2-12, 14, 15 and 31-39, dependent thereon, are adequately described in Applicants’ specification as filed. Reconsideration and withdrawal of this rejection is therefore respectfully requested.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully submit that the pending claims are in condition for allowance. If a telephone interview would advance prosecution of the application, the Examiner is invited to call the undersigned at the number listed below.

No fees are believed to be due in connection with the filing of this Amendment, however the Commissioner is authorized to debit Deposit Account No. 08-0219 for any required fee necessary to maintain the pendency of this application.

Respectfully submitted,



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